

REMARKS

In the Office Action dated November 15, 2006, claims 1-26 were presented for examination. The Examiner rejected claims 1-26 under 35 U.S.C. §112, second paragraph, claims 1-24 under 35 U.S.C. §103(a) over *Moore et al.* in view of *Logue et al.* and further in view of Applicant's Admitted Prior Art, and claims 25-26 under 35 U.S.C. §103(a) over *Moore et al.* in view of *Logue et al.*

Applicant's remarks pertaining to *Moore et al.*, *Logue et al.*, and Applicant's Admitted Prior Art (AAPA) made in the prior communications for this application are hereby incorporated by reference.

I. Rejection of claims 1, 10, 19, and 25

In the Office Action dated November 15, 2006, the Examiner rejected claims 1, 10, 19, and 25 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner noted that the term "the group" does not have sufficient antecedent basis. Applicant respectfully disagrees. The portion of the claim is a markush grouping of elements. A proper markush grouping uses the phrase "selected from the group consisting of". "Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C."¹ An improper use of the markush expression would be "selected from a group consisting of". Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1, 10, 19, and 25 under 35 U.S.C. §112, second paragraph.

¹ MPEP §2173.05(h), citing *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

II. Rejection of claims 1-24 under 35 U.S.C. §103(a)

Claims 1-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore et al.* in view of *Logue et al.*, and further in view of Applicant's Admitted Prior Art (AAPA).

Applicant's remarks pertaining to *Moore et al.*, *Logue et al.*, and AAPA provided in response to the prior Office Actions are hereby incorporated by reference.

The Examiner's evaluation of the prior art references in view of Applicant's claimed invention does not elicit any motivation or suggestion to combine *Moore et al.*, *Logue et al.*, and AAPA. Because this basic requirement to uphold a rejection under 35 U.S.C. §103(a) was not met, Applicant respectfully requests removal of the rejection and allowance of claims 1-24.

The first and second steps required for evaluating a prior art reference under 35 U.S.C. §103(a) are to first determine the scope and contents of the prior art and then ascertain the differences between the prior art and the claims in issue.² As noted by the Examiner, *Logue et al.* is used to teach "receiving a request from a remote administrator", *Moore et al.* is used to teach "launching of a lower priority task from a higher priority task", and AAPA is used to teach communication of tasks in firmware. See Office Action, page 3, Item 6, second paragraph.

Logue et al. does not teach or suggest operating in system firmware. It is clear that the administrator of Applicant is not equivalent to the administrator of *Logue et al.*, as the administrator of Applicant is claimed as operating in system firmware and the administrator of *Logue et al.* clearly does not demonstrate use of the administrator in system firmware. The administrator of *Logue et al.* is set to receive hit tracking information, *i.e.* statistical data,

² *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) (holding that under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined).

associated with browsing a distributed network. See Col. 4, lines 65-67. “Remote site administrator 480 may include entities such as persons authorized to gather statistical data for the remote site, persons authorized to manage and maintain the remote site, the remote site itself, or an automated computer system or other device configured to receive statistical data for the remote site.” Col. 5, lines 2-7. There is no association between the administrator of *Logue et al.* the administrator claimed by Applicant.

Similarly, *Moore et al.* does not pertain to receipt of a message from a remote administrator or any other element operating in system firmware, as claimed by Applicant. *Moore et al.* clearly does not operate in or receive communication or a message from system firmware as there is no demonstration of such communication in system firmware. In fact, *Moore et al.* teaches operation in system middleware, see paragraph 64, which is not system firmware.

It is Applicant’s position that neither *Logue et al.* nor *Moore et al.* pertain to the claimed subject matter and therefore neither is analogous art. “The analogous art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.”³ It is Applicant’s position that *Logue et al.* is not a proper reference for application under 35 U.S.C. §103(a) as one of ordinary skill in the art would not have reasonably expected to look for a solution in *Logue et al.* to the problem faced by the inventor as it does not pertain to operating within system firmware. Similarly, it is Applicant’s position that *Moore et al.* is not a proper reference for application under 35 U.S.C. §103(a) as one of ordinary skill in the art would not have reasonably expected to look for a solution in *Moore et al.* to the problem faced by the invention as *Moore et al.* does not pertain to launching of such tasks in response to receipt from an element in system firmware. As the courts have stated:

³ *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his rejection. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.⁴

Furthermore, even if one were to consider *Moore et al.* and *Logue et al.* as analogous art, in order to combine prior art references under 35 U.S.C. §103(a), the prior art references must have a suggestion or motivation to modify the references or combine the teachings.⁵ “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure.”⁶ It is Applicant’s position that there is no motivation in the prior art references for combining *Moore et al.*, *Logue et al.* and *AAPA*. Rather, the motivation for such a combinations stems from the language in Applicant’s claims.

Moore et al. teaches receipt of a message from a remote administrator and launching a lower priority task from a higher priority task. The Applicant’s dispute that *Moore et al.* provides a basis for such functionality within system firmware, or from a remote administrator in system firmware. *Logue et al.* also does not provide support for the remote administrator within system firmware. Although *AAPA* teaches communication of tasks within system firmware, *AAPA* clearly discusses the limitations of launching a lower priority task from a higher priority task within system firmware. There is no teaching or suggestion in *Moore et al.* to modify the invention for launching such tasks in response to receipt of a message from a remote administrator operating in system firmware, as the invention of *Moore et al.* does not relate to firmware. To modify the teaching of *Moore et al.* for receipt of a message from a remote administrator in system firmware as claimed by Applicant would go against the teaching of *Moore et al.* or would modify *Moore et al.* in a way not contemplated by *Moore et al.*

⁴ *In re Clay*, 966 F.2d 656, 659-660 (Fed. Cir. 1992).

⁵ See MPEP §2143.

⁶ MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Based upon *Moore et al.*'s teaching, it is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."⁷ Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *Moore et al.*

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusive statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicant's specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references".⁸ It is respectfully suggested that the Examiner's rejection under 35 U.S.C. §103(a) which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant's respectfully contend that the combination of *Moore et al.* with *Logue et al.* and AAPA does not meet the

⁷ *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991).

⁸ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests allowance of claims 1-24.

III. Rejection of claims 25 and 26 under 35 U.S.C. §103(a)

Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore et al.* in view of *Logue et al.*

Applicant's remarks to *Moore et al.* and *Logue et al.* in response to the prior Office Actions and presented previously in this document are hereby incorporated by reference.

Applicant's claim 25 pertains to a remote administrator that operates in system firmware and is used to receive and communicate messages associated with task management. As noted above and admitted by the Examiner, neither *Moore et al.* nor *Logue et al.* pertain to operation in or communication with an element in system firmware. The rejection of claims 25-26 clearly states "Claims 25-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore et al.* (US Pat. Application Publication US 2004/0133609) in view of *Logue et al.* (U.S. 6,647,421)." ⁹

There is no teaching or suggestion in *Moore et al.* to modify the invention for launching such tasks in response to receipt of a message from a remote administrator operating in system firmware, as the invention of *Moore et al.* does not relate to firmware. To modify the teaching of *Moore et al.* for receipt of a message from a remote administrator in system firmware as claimed by Applicant would go against the teaching of *Moore et al.* or would modify *Moore et al.* in a way not contemplated by *Moore et al.*

⁹ See Office Action dated November 15, 2006, page 7, paragraph 21.

Similarly, there is no teaching or suggestion in *Logue et al.* to modify the invention for the remote administrator to operate in system firmware, as the invention of *Logue et al.* does not relate to firmware. To modify the teaching of *Logue et al.* for operation of the remote administrator in system firmware, as claimed by Applicant, would go against the teaching of *Logue et al.* or would modify *Logue et al.* in a way not contemplated by *Logue et al.*

Based upon the teachings of both *Moore et al.* and *Logue et al.*, it is clear that the prior art references do not teach all of the elements claimed by Applicant. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”¹⁰ It is Applicant’s position that the combination of prior art references as asserted by the Examiner does not teach or suggest the elements of Applicant’s claims 25 and 26.

Furthermore, even if one were to interpret the combination of *Moore et al.* and *Logue et al.* to teach all of the claim limitations, it is Applicant’s position that the Examiner is taking the elements of Applicant’s pending claims and combining them in an improper manner. “It is impermissible to use the claimed invention as an instructions manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.”¹¹ Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant’s invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant’s pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *Moore et al.*

It is well settled that each statement of obviousness for the purpose of combining each of

¹⁰ MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

¹¹ *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991).

the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusive statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicant's specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references".¹² It is respectfully suggested that the Examiner's rejection under 35 U.S.C. §103(a) which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Moore et al.* and *Logue et al.* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests that the Examiner direct allowance of claims 25-26.

IV. Conclusion

Based upon the above remarks, Applicant respectfully requests consideration of the claims. It is submitted that all of the claims in the application are in condition for allowance and such action is respectfully requested. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

¹² *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For the reasons outlined above, an allowance of this application is respectfully requested.

Respectfully submitted,

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